

REMARKS/ARGUMENTS

Claims 1-7 and 9 are pending.

The Office Action dated May 9, 2006, rejects: claims 1-5 and 9 under 35 USC 130(a) as being unpatentable over Green et al. (U.S. Patent No. 3,830,434) in view of Hough (U.S. Patent No. 5,918,814); and claims 6 -7 under 35 USC 130(a) as being unpatentable over Green et al. in view of Hough, and in further view of Colo'n (U.S. Patent No. 6,209,803).

The Rejection of Claims 1-5 and 9 under 35 USC 103(a)

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03; citing *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson* 165 USPQ 494, 496 (CCPA 1970).

The Green reference fails to disclose all of the limitations of independent claim 1. Independent claim 1 has as limitations the following:

"a lip extending horizontally away from the wall along an upper perimeter thereof for supporting the shield adjacent a sprinkler head without attachment thereto;
and
a notch located substantially near a lower perimeter of the sloping wall and **configured to accommodate movement of the sprinkler head relative to the plate**". (emphasis added)

The Office Action states that reference number 30 of Green allegedly discloses a sprinkler head shield comprising a concave inwardly sloping wall defined by a partially circular, single-piece curved plate. However, reference number 30 only refers to a conical cut-out or depression in the earth around each sprinkler head. Even if the Office Action intended to refer to reference number 31 which describes a circular metal or plastic cover plate having a conical shaped depression, reference number 31 does not

disclose a concave wall, as is required by claim 1. Fig. 2 of Green illustrates a cross-sectional view of a curved wall that is clearly not concave. None of the references cited by the Office Action disclose a concave inwardly sloping wall as required by claim 1. The Office Action simply states that a concave sloping wall is disclosed while failing to provide a reference that actually disclosed this feature.

The Office Action states that Green allegedly teaches a lip (31) extending horizontally away from the wall along an upper perimeter thereof. However, the Office Action fails to discuss the requirement of claim 1 that the shield be adjacent a sprinkler head without attachment thereto. Specifically, Green does not teach non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. The above underlined limitations of claim 1 require that the shield not be attached to the sprinkler head and that the sprinkler head move relative to (or independent of) the shield. Neither of these limitations are taught by Green. Green discusses various placements of the sprinkler head relative to ground level, but does not discuss movement of the sprinkler head during operation. Regardless, Green specifically teaches:

“a central opening 33 may be snapped into the annular groove 12 so that its under surface rests on the surface of the ground with the prongs 32 inserted therein to cover the conical cut-out 30 in the earth, allow unobstructed access to the hexagon body portion of the sprinkler head. This type of installation prevents accidental lateral movement and damage to the sprinkler head.” (col. 4, lines 33-38)
(emphasis added)

Such teachings clearly show that the shield of Green is secured to the sprinkler to prevent movement of the sprinkler with respect to the shield. In contrast, the shield in independent claim 1 is not attached to the sprinkler head and is specifically designed to permit movement of the sprinkler head relative to the plate.

Indeed, if the teachings of Green were applied to the instant application, then the stated purpose of the instant application would be frustrated. Specifically, if the shield of the instant application, being secured to the ground, were attached to the sprinkler head, then the shield itself would prevent the sprinkler head from popping up. The stated purpose of the shield in the instant application is to prevent vegetation from growing over the sprinkler head and interfering with the sprinkler head popping up.

The Office Action admits that Green does not teach a notch located substantially near a lower perimeter of the sloping wall that is configured to accommodate movement of the sprinkler head relative to the plate. The Office Action claims that Green discloses a notch located substantially near a lower perimeter of the sloping wall but fails to identify the reference number associated with this alleged notch in the figures or where this alleged notch is discussed in the Green specification. The Applicant is forced to bear the burden of having to assume the Office Action was referring to central opening 33 of the cover plate 31 as the so-called "notch" of Green. The Office Action attempts to use the Hough reference to make up for the deficiencies of the Green reference but fails to do so for the same reasons discussed in the response to the previous Office Action. The combination of Green with Hough simply does not teach the above-discussed limitations. Hough does not teach non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. Hough only teaches that the hole in the protector is sized to allow a sprinkler head to protrude. (col. 3, lines 48-49).

With respect to claims 5 and 9, the Office Action states that the notch of Green is centrally located with respect to the shield and the walls slope inwardly towards the notch. However, the Office Action failed to indicate by reference number or in any other manner what specific structure it considered to be covered by the term "a notch". The Applicant can only speculate that the Office Action was referring to central opening 33 of the cover plate. The Office Action also fails to explain how, with respect to claim 9, the wall of Green slopes outwardly from a center defined by the at least partially circular shield. Both claims 5 and 9 state that the notch is centrally located with respect to the shield. However, claim 5 states that the wall slopes inwardly towards the notch while

claim 9 states that the wall slopes outwardly from a center defined by the at least partially circular shield. The Office Action is silent with respect how the reference allegedly discloses the “outwardly” language of claim 9.

The invention claimed in claims 2-4 is further distinguished from Hough in that the sloping wall of the shield is generally concave. Hough teaches a shield with a convex shape. The added limitations of claims 2-4 further distinguish these claims over the cited art. There’s no motivation or suggestion to modify the integral spike arrangement of Green for the apertures and separate spikes of the Hough reference. The Office Action states that it would have been obvious to one skilled in the art at the time the invention was made to have modified the shield of Green with the sprinkler accommodating centrally located notch and the apertures and spikes of Hough in order to create a sprinkler shield that can be held stationary in view of a rotating sprinkler with an anchoring system with external fasteners that would be more economical to manufacture. However, none of the references provide any motivation or suggestion to modify Green in this manner for the reasons set out by the Office Action. In fact, one would be hard-pressed to explain how it is more economical to manufacture the anchoring system of Hough with separate, external fasteners than the anchoring system of Green that uses prongs integral with the sprinkler shield. The anchoring system of Green is actually far less complicated than the system of Hough and far more economical to manufacture than the system of Hough.

Additionally, the modification of Green in view of the Hough or Colo’n references actually renders the Green reference unsuitable for its intended purpose as the Green reference states that the sprinkler heads may be installed in a sprinkler system with their respective outlets 23 slightly below or entirely above the ground level, as illustrated in Fig. 2. The respective ground levels are represented by reference numbers 29 and 29’. See Green, col. 4, lines 24-28. The anchoring system of Hough is only intended for use with a sprinkler protector situated above the ground as the bottom of the protector is designed to rest on top of the ground. There is no suggestion or motivation that the anchoring system of Hough can be used with the cover plate 31 of Green in

both situations. Green and Hough are not properly combinable as they are directed to solving two different problems in two different ways.

The Rejection of Claims 6 and 7 under 35 USC 103(a)

With respect to the rejections of claims 6 and 7 in view of the additional Colo'n reference, the Colo'n reference does not make up for the deficiencies of either the Green or Hough references. Claims 6 depends from independent claim 1 and claim 7 depends from claim 6 and, as discussed above, the Green and Hough references fail to teach all of the claim limitations set forth in independent claim 1. Specifically, neither Green nor Hough teaches non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. The invention claimed in claims 6 and 7 is further distinguished from Colo'n in that the sloping wall of the shield is generally concave. Colo'n teaches a shield with a convex shape. The added limitations of claims 6 and 7 further distinguish these claims over the cited art.

In addition, the Green, Hough and Colo'n references are simply not properly combinable as they solve different problems in different ways. The Office Action is combining features of Colo'n that are directed to two very different embodiments in order to meet the requirements of claim 7 in particular. The insert disclosed by Colo'n is quite different from the insert discussed in claim 7 of the instant application. The engagement of the insert 70 of Colo'n with the protector 60 is not specifically mentioned but the Office Action suggests that Figure 4 of Colo'n discloses the engagement of an insert with a protector where the insert is longitudinally moved, relative to the protector, into engagement with an opening of the protector 60. The Office Action states that reference number 26b (Fig. 4) discloses a groove. However, Colo'n does not actually disclose a groove into which the insert 70 is slid as the so-called "groove" is actually a "shoulder" 22b (col. 2, line 62) of the opening 28. A "shoulder" and a "groove" are two very distinct structural features. The insert 70 abuts against the shoulder but does not slide into the shoulder.

Accordingly, independent claim 1, and each of its dependent claims 2-7 and 9 are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP



Scott W. Kelley
Registration No. 30,762

SWK/nn
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900